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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,344

05/05/2006

Florence Henry

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EXAMINER

CHEN, CATHERYNE

ART UNIT

PAPER NUMBER

1655

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,344	<b>Applicant(s)</b> HENRY ET AL.	
	<b>Examiner</b> CATHERYNE CHEN	<b>Art Unit</b> 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>May 5, 2006, March 27, 2007, May 8, 2008</u> .                | 6) <input type="checkbox"/> Other: _____                          |



### **DETAILED ACTION**

Currently, Claims 1-11 are pending. Claims 1-8 are examined on the merits.

### ***Election/Restrictions***

Claims 9-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on Feb. 28, 2008.

Applicant's election with traverse of Group I (Claims 1-8) and the species schizandrin and a stabilizer, in the reply filed on Feb. 28, 2008 is acknowledged. The traversal is on the ground(s) that it would not be an undue burden to search all of the claims and species. This is not found persuasive because a search of one group is not coextensive with the search of the other groups. Thus, it would be burdensome to search the entire set of claims.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda et al. (JP 06279256 A) with Newmark et al. (US 6242012 B1) providing evidence of inherent characteristics of Ikeda et al.

Ikeda et al. teaches skin care cosmetics containing crude Chinese medicine of Gomishi extracted with water, skin lotion was prepared with glycerine (stabilizer) and refined water (additive) (Abstract). Schisandra chinensis is abbreviated as Schisandra, which is known by the name Gomishi (see Specification, page 1, lines 22-31). Sometimes Schisandra is spelled Schizandra. Crude Gomichi extract would inherently contain schizandrin, deoxyschizandrin, schisandrin C, gomisin A, gomisin N, pregomisin, and nordihydroguaiaretic acid because compounds in schizandra are called schizandrins (see Newmark et al., column 1, lines 46).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newmark et al. (US 6242012 B1).

Newmark et al. teaches schizandra has schizandrins (column 1, line 46), for oral administration or topical administration as a cream (column 3, lines 66-67), with conventional pharmaceutical carriers; aqueous powder or oily bases; thickeners and the like may be necessary or desirable (column 7, lines 41-47). Schizandra extract would intrinsically contain schizandrin, deoxyschizandrin, schisandrin C, gomisins A, gomisins N, pregomisin, and nordihydroguaiaretic acid.

The reference does not teach all the ingredients in one composition. However, the reference does teach that each of the claimed ingredients is suitable for combination in a pharmaceutical composition. Thus, an artisan of ordinary skill would be reasonably expected that the claimed ingredients could be combined together to produce a single pharmaceutical product. This reasonable expectation of success would motivate the artisan to combine the claimed ingredients together into a single composition.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sung et al. (WO 01/41778 A1) and Newmark et al. (US 6242012 B1).

Sung et al. teaches schizandrin extracted from schizandra (page 5, lines 19-21) with distilled water as stabilizer (page 6, line 15). The melanin synthesis inhibition compound of the present invention can be used as a cosmetic or pharmaceutical skin whitener (page 16, lines 6-9). Schizandra extract would intrinsically contain schizandrin,

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deoxyschizandrin, schisandrin C, gomisin A, gomisin N, pregomisin, and nordihydroguaiaretic acid (see Newmark et al., column 1, lines 46).

The reference does not teach all the ingredients in one composition. However, the reference does teach that each of the claimed ingredients is suitable for combination in a pharmaceutical composition. Thus, an artisan of ordinary skill would be reasonably expected that the claimed ingredient could be combined together to produce a single pharmaceutical product. This reasonable expectation of success would motivate the artisan to combine the claimed ingredients together into a single composition.

### ***Conclusion***

No claim is allowed.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catheryne Chen whose telephone number is 571-272-9947. The examiner can normally be reached on Monday to Friday, 9-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Catheryne Chen,  
Patent Examiner  
Art Unit 1655

/Terry A. McKelvey/  
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